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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,168	08/09/2001	Charles E. Slone	Slone.C-05	5323

22197 7590 11/28/2003

GENE SCOTT; PATENT LAW & VENTURE GROUP  
3140 RED HILL AVENUE  
SUITE 150  
COSTA MESA, CA 92626-3440

EXAMINER
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WILSON, JOHN J

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 11/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/927,168	SLONE, CHARLES E.	
	Examiner	Art Unit	
	John J. Wilson	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. A work piece that is axially orthogonal to the longitudinal axis of the handle was not disclosed by the original disclosure and is held to be improper new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 14, "the exterior surface" lacks proper antecedent basis within the claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maitland (4696646). Maitland shows a light concentrating apparatus with an elongated handle 10, Fig. 9, light transmissive element 1 at the end of the handle and having an outwardly facing light receiving top surface 4, Figs. 1 and 4, and a laterally extending curved shaped body 2 axially normal to the top surface terminating in an integral end 5 that is downwardly curved as shown and defines an axis that is at an angle with respect to the longitudinal axis of the handle as shown in Fig. 9. The specific angle with respect to the handle is an obvious matter of choice in the degree of a known parameter and in the manner of holding the work piece to one of ordinary skill in the art. The light transmissive element has a generally curved shape as shown. To use a full cone shape is an obvious matter of choice in the non-critical shape of a known element to the skilled artisan. To call end 5 a work piece is an obvious matter of choice in terminology and/or the intended use of a known structure. As to claim 3, see receiving surface on the inside of the arms of handle 10 as shown and the insertion surface on the side of element 4. As to claim 4, the specific shape of the surfaces used is an obvious matter of choice in the shape of a known element to one of ordinary skill in the art. As to claim 13, the shown element has a hyperbolic outer surface. As to claim 16,

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see 6, 6' of Maitland. To use as a guide is an obvious matter of choice in the intended use of the shown structure to the skilled artisan.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maitland (4696646) in view of Adam et al (5711665). Maitland does not show the use of a coating. Adam teaches a hard coating, column 7, lines 1-5. It would be obvious to one of ordinary skill in the art to modify Maitland to include a hard coating as shown by Adam in order to render the tool more wear resistant.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maitland (4696646) in view of Huston et al (3977410). Maitland does not show an enlarged medial portion on the handle. Huston shows an enlarged medial portion 24, 28. It would be obvious to one of ordinary skill in the art to modify Maitland to include an enlarged portion as shown by Huston in order to better grip and manipulate the handle.

### ***Response to Remarks***

Applicant's remarks filed October 3, 2003 have been considered, however, are not deemed to be persuasive. With respect to the shape of the cone, there is no disclosed criticality to the use of a partial or full cone, and therefore, the limitation of shape is properly held to be obvious. With respect to hyperbolic, as stated above, the Maitland shows a curved surface in the form of a partial cone. With respect to the limitation of direction of the axis of symmetry, this axis is described in the specification

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as being defined by a flat surface on the work piece, see Figs 15 and 16 of the present disclosure, however, the claims are not so limited, therefore, it is proper to interpret the axis of symmetry as being in any chosen direction of intended use.

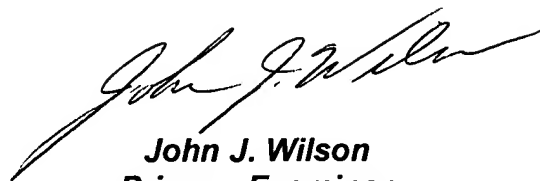
### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication should be directed to John Wilson at telephone number (703) 308-2699.

A handwritten signature in black ink, appearing to read "John J. Wilson", with a long, sweeping underline.

**John J. Wilson**  
**Primary Examiner**  
**Art Unit 3732**

jjw

November 21, 2003

Fax (703) 308-2708

Work Schedule: Monday through Friday, Flex Time